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EXAMINER

CHEUNG, MARY DA ZHI WANG

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 07/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/035,347

Applicant(s)

REEDER ET AL.

Examiner

Mary Cheung

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/9/2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

17

DETAILED ACTION

Status of the Claims

1. This action is in response to the amendment filed on May 9, 2005. Claims 1-29 are pending. Claims 1, 3-4, 6-7, 11-13, 16-17, 19-20, 25 and 27-28 are amended.

Response to Arguments

2. Applicant's arguments filed May 9, 2005 have been fully considered but they are not persuasive.

In response to the applicant's arguments that Misra (U. S. Patent 6,189,146) fails to teach visually present to a first potential licensee a first license form including license terms defined by the first intellectual property rights licensor, and present to a second potential licensee a first license form including license terms defined by the first intellectual property rights licensor as claimed in claim 7, examiner respectfully disagrees because this matter is taught by Misra as plurality of licenses with various license terms are provided to plurality of potential licensees (see the rejection for claim 7 below).

In response to the applicant's arguments that Misra fails to teach electronically receiving from a rights licensor of a first media an instruction defining which system entities and entity attributes can be used as search parameters by a search engine as claimed in claim 11, examiner believes that this matter is taught by Misra as various of attributes that related to license rights are received from the licensor server (column 10 line 45 – column 11 line 30 and Fig. 3). Furthermore, in response to the applicant's arguments that Misra fails to teach electronically receiving from the rights licensor

instructions as to what human perceptible notifications are to be provided to the rights licensor and to the potential licensee during the licensing transaction, examiner believes that this limitation is taught by Misra as according to the license instructions, the right licensor and the potential licensee send each other responses corresponding to the license request (column 15 line 47 – column 16 line 37 and Figs. 6-7).

In response to the applicant's arguments that Misra fails to teach receive a user response including a license acceptance, or an indication that the first user is not proceeding with the licensing transaction as claimed in claim 25, examiner believes that this limitation is taught by Misra as the user sending a correct response in order to get authentication of the license (column 11 Table 5 and column 15 line 47 – column 16 line 37 and Figs. 3, 6-7). Furthermore, Misra teaches plurality of media properties with various type of licenses are provided to plurality of users (see rejection for claim 25), which corresponds to transmit over a network to a first user first licensing terms defined by a licensor for a first media property and transmit over a network to a second user second licensing terms defined by a licensor for a second media property.

In response to the applicant's arguments that Misra fails to teach the license request and the license template entries that received from the licensee are manually provided. Examiner believes that manually providing information from one party to another party is well known in the art and traditional practice in the business, such as submitting paper document from one company to another company. Thus, it would have been obvious to one of ordinary skill in the art to allow the license request and

Art Unit: 3621

license template entries in Misra's teaching to be provided manually by the licensee for simplifying the media rights licensing apparatus.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 7-9, 11-12, 14-20 and 24-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Misra et al., U. S. Patent 6,189,146.

As to claims 7 and 19, Misra teaches a system for managing intellectual property rights, comprising (Fig. 3):

a) a first module configured to receive over a network information related to intellectual property rights available for at least a first property from an intellectual property rights licensor and for at least a second property from a second intellectual property owner (column 7 lines 21-64 and column 8 line 60 – column 10 line 2 and Fig. 3; *specifically, the first property, the first intellectual property rights licensor, the second property, and the second intellectual property owner correspond to plurality of properties with various intellectual property rights are provided from license server*);

b) a repository coupled to the first module, wherein the repository is configured to store the information related to the intellectual rights for the first property and the second property(column 8 line 60 – column 10 line 2 and Fig. 3);

c) a second module configured to:

i) visually present to a first potential licensee a first license form including license terms defined by the first intellectual property rights licensor

(column 15 line 56 – column 16 line 6 and Fig. 7; *specifically, “a first license form” corresponds to the platform challenge sent to the potential licensee in Misra’s teaching*);

ii) receive data entered into the first license form by the first potential licensee, the data including a request to license a first right (column 15 line 56 – column 16 line 6 and Fig. 7);

iii) determine if the first right is available, and if the first right is available, to submit the first license request, including at least a portion of the received data, for approval (column 15 lines 4-28 and Fig. 6; *specifically, the “licensor” corresponds to the secure license store 112 in Misra’s teaching*);

iv) transmit a first license approval to the first potential licensee (column 15 lines 11-28 and Fig. 6);

v) visually present to a second potential licensee a second license form including license terms defined by the second intellectual property rights licensor (column 12 lines 40-55 and column 15 line 56 – column 16 line 6

and Fig. 7; *specifically, the second potential licensee and the second license correspond to the plurality of licenses are issued to plurality of clients in Misra's teaching*);

vi) receive data entered into the second license form by the second potential licensee, the data including a request to license a second right (column 15 line 56 – column 16 line 6 and Fig. 7);

vii) determine if the second right is available, and if the second right is available, to submit the second license request, including at least a portion of the received data, for approval (column 15 lines 4-28 and Fig. 6; *specifically, the "licensor" corresponds to the secure license store 112 in Misra's teaching*);

viii) transmit a second license approval to the second potential licensee (column 15 lines 11-28 and Fig. 6).

As to claim 8, Misra teaches the license approval is provided by the licensor after the received data is transmitted to the licensor (column 15 lines 4-28 and Figs. 6-7).

As to claim 9, Misra teaches the repository is configured to indicate when the first right has been licensed to the potential licensee in real time (column 15 lines 25-28).

As to claim 11, Misra teaches a method of managing and licensing rights associated with media, the method comprising (Fig. 3):

a) electronically receiving from a rights licensor of a first media an instruction defining which system entities and entity attributes can be used as search

parameters by a search engine (column 10 line 45 – column 11 line 30 and Fig. 3);

b) electronically receiving from the rights licensor a definition of information types that a potential licensee is to provide in a license request submission for at least a first right for the first media (column 9 Table 4 and column 11 Table 5 and column 15 line 66 – column 16 line 6 and Fig. 3);

c) electronically receiving from the rights licensor instructions as to what human perceptible notifications are to be provided to the rights licensor and to the potential licensee during the licensing transaction (column 15 line 47 – column 16 line 37 and Figs. 6-7; *specifically, this limitation is taught by Misra as according to the license instructions, the right licensor and the potential licensee send each other responses corresponding to the license request*);

d) electronically receiving from the rights licensor authorizing instructions configured to specify which person is authorized to perform predetermined acts during the licensing transaction (column 10 line 60 – column 12 line 14 and column 15 lines 4-28 and Figs. 3, 6);

e) conducting, using a computer system, the licensing transaction in accordance with the rights licensor's notification instructions, rights licensor defined workflow, and authorizing instructions (column 15 line 47 – column 16 line 37 and Figs. 6-7).

As to claim 12, Misra teaches receiving a licensing a request over the Internet from the potential licensee (column 4 lines 9-14).

As to claim 14, Misra teaches the system entities include one or more of properties, rights, requests, agreements, licenses, licensees, and licensors (column 9 Table 4 and column 11 Table 5).

As to claim 15, Misra teaches the system attributes include one or more of a term start, and a term end (column 11 Table 5).

As to claim 16, Misra teaches the rights licensor uses a license template to define the information types that the potential licensee is to provide (column 15 line 56 – column 16 line 6 and Fig. 7; *specifically, “a license template” corresponds to the platform challenge sent by the license server in Misra’s teaching*).

As to claim 17, Misra teaches the rights licensor specifies how the notifications are to be provided and such licensor specification on how the notifications are to be provided is stored in computer readable memory (column 15 line 47 – column 16 line 37 and Fig. 6).

As to claim 18, Misra teaches at least one of the notifications includes status information on the licensing transaction (column 15 lines 50-54 and column 16 lines 35-37).

As to claim 20, Misra teaches if the response from the rights licensor is a license approval, further comprising updating in real time a database stored in computer readable memory and used to store right status information (column 15 lines 25-29).

As to claim 24, Misra teaches the first media is a document (column 14 lines 47-48 and Figs. 3-6).

As to claim 25, Misra teaches an apparatus for managing licensing transactions related to media rights, the apparatus comprising instructions stored in computer readable memory configured to (Fig. 3):

- a) transmit over a network to a first user first licensing terms defined by a licensor for a first media property (column 9 Tables 3-4 and column 11 Table 5);
- b) receive over a network a license inquiry from the first user regarding at least a first right for the first media property (column 13 line 66 – column 14 line 59 and Figs. 3, 5-6);
- c) receive a response from the first user to the first licensing terms, the first user response including a license acceptance, or an indication that the first user is not proceeding with the licensing transaction (column 11 Table 5 and column 15 line 47 – column 16 line 37 and Figs. 3, 6-7);
- d) set a first status in real-time related to the first right at least partly in response to the first user response (column 15 line 4 – column 16 line 37 and Figs. 3, 6-7);
- e) transmit a notification relating to the user response to a recipient designated by the licensor (column 15 line 47 – column 16 line 37 and Figs. 3, 6);
- f) receive an instruction from the licensor after transmitting the notification, and at least partly in response to the instruction, to set a second status related to the first right (column 15 lines 25-29);
- g) transmit over a network to a second user second licensing terms defined by a licensor for a second media property (column 9 Tables 3-4 and column 11 Table 5 and column 12 lines 40-55; *specifically, the second user, the second licensing*

terms and the second media property correspond to plurality of media properties with various type of licenses are provided to plurality of users in Misra's teaching);

h) receive over a network a license inquiry from the second user regarding at least a second right for the second media property (column 13 line 66 – column 14 line 59 and Figs. 3, 5-6);

i) receive a response from the second user to the second licensing terms, the second user response including a license acceptance, or an indication that the second user is not proceeding with the licensing transaction (column 11 Table 5 and column 15 line 47 – column 16 line 37 and Figs. 3, 6-7);

j) set a second status in real-time related to the second right at least partly in response to the second user response (column 15 line 4 – column 16 line 37 and Figs. 3, 6-7);

k) transmit a notification relating to the user response to a recipient designated by the licensor (column 15 line 47 – column 16 line 37 and Figs. 3, 6);

l) receive an instruction from the licensor after transmitting the notification, and at least partly in response to the instruction, to set a second status related to the second right (column 15 lines 25-29).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3621

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misra et al., U. S. Patent 6,189,146.

As to claim 26, Misra teaches a license inquiry from a user as discussed in claim 25 above. Misra does not specifically teach the user inquiry specifies a license time period. However, Misra teaches license term comprising time period (column 11 Table 5). It would have been obvious to one of ordinary skill in the art to allow the user inquiry in Misra's teaching to include specifying a license time period so that the licensor can quickly match the user's inquiry.

As to claim 27, Misra teaches the user inquiry specifies a territory for the license (column 8 Table 2 and column 15 line 66 – column 16 line 6). Misra does not specifically teach the user inquiry specifies a territory including a governmental and/or a geographic regional territory. It would have been obvious to one of ordinary skill in the art to allow the user inquiry in Misra's teaching to include specifying a territory including a governmental and/or a geographic regional territory so that the licensor can quickly match the user's inquiry.

As to claim 28, Misra teaches the user inquiry specifies a media language (column 8 Table 2 and column 15 line 66 – column 16 line 6). Misra does not specifically teach the user inquiry specifies a media language that is a human language. It would have been obvious to one of ordinary skill in the art to allow the user inquiry in Misra's teaching to include specifying a media language that is a human language so that the user can easily interact with computer instructions.

Art Unit: 3621

7. Claims 1-6, 13, 21-23 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misra et al., U. S. Patent 6,189,146 in view of Griswold, U. S. Patent 5,940,504.

As to claims 1 and 3, Misra teaches a media lights licensing apparatus, comprising (Fig. 3):

- a) a rights owner application stored in computer readable memory and configured to execute on a computer configured to receive rules, and a license request template defined by a rights owner (column 7 lines 21-64 and column 8 line 60 – column 10 line 2 and column 15 line 56 – column 16 line 6 and Figs. 3, 7; specifically, *“a rights owner” corresponds to the license server in Misra’s teaching, and “a license request template” corresponds to the platform challenge sent from the license server as shown in Fig. 7 and column 15 line 56 – column 16 line 6*);
- b) a repository database stored in computer readable memory and coupled to the rights owner application, wherein the repository is configured to store the rules, and license request templates defined by the rights owner (column 8 line 60 – column 10 line 2 and Fig. 3);
- c) a rights exchange application stored in computer readable memory and coupled to the repository database, the rights exchange application configured to (Intermediate Server 32 in Fig. 3) :
 - i) receive a licensing request provided by a potential human licensee related to a first media property (column 14 lines 14-29 and Figs. 3, 5);

- ii) conduct a licensing transaction of at least a first right associated with the first media property by determining rights available for the first media property by searching the repository database (column 14 line 49 – column 15 line 28 and Figs. 3, 5-6);
- iii) cause a first license template defined by the rights owner to be visually presented to the potential human licensee (column 14 line 64 – column 15 line 3 and Figs. 3, 6-7);
- iv) receive first license template entries provided by the potential licensee (column 15 lines 4-8 and Figs. 3, 6-7);
- v) transmit in real-time the first license template entries to be visually presented to the rights owner (column 15 lines 4-28 and Figs. 6-7);
- vi) receive from the rights owner approval of a license for the first right, and to transmit the approval to the potential licensee (column 15 lines 9-28 and Figs. 3, 6-7).

Misra teaches electronically providing the license request and the license template entries from the licensee (column 14 lines 14-29 and column 15 lines 4-8). Misra does not specifically teach license request and the license template entries that received from the licensee are manually provided. However, manually provided information from one party to another party is well known in the art and traditional practice in the business, such as submitting paper document from one company to another company. Thus, it would have been obvious to one of ordinary skill in the art to

allow the license request and license template entries in Misra's teaching to be provided manually by the licensee for simplifying the media rights licensing apparatus.

Misra does not specifically teach the rights owner application receiving pricing rules and payment rules, and the repository database store the pricing rules. However, Griswold teaches the rights owner has pricing rules and payment rules for licenses provide to the licensee, and a repository database stores the pricing rules (column 3 lines 38-41 and column 4 lines 34-40 and Figs. 1-2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the rights owner application in Misra's teaching to include the feature of pricing rules and payment rules, and further to include the feature of storing the pricing rules by a repository database as taught by Griswold for allowing the rights owner to better managing his or her property.

As to claim 2, Misra teaches a rights search engine wherein the rights owner can configure which system entities and which attributes for the system entities can be used as searchable parameters by the search engine (column 9 lines 29-67 and column 10 lines 53-59).

As to claim 4, Misra teaches a plurality of rules stored in computer readable memory and defined by the rights owner, the rules configured to define which media rights licensing apparatus users are authorized to perform predefined actions (column 10 line 60 – column 12 line 14 and Fig. 3).

As to claim 5, Misra teaches the predefined actions include accepting a licensing request and denying a licensing request (Figs. 5-7).

Art Unit: 3621

As to claim 6, Misra teaches a plurality of notifications defined by the rights owner, the plurality of notifications configured to be issued during the licensing process in response to criteria specified by the rights owner (column 15 lines 47-54 and column 16 lines 7-37 and Fig. 6).

As to claim 13, Misra teaches managing licensing rights as discussed in claim 11 above. Misra does not specifically teach electronically receiving from the rights licensor pricing, payment and delivery rules. However, Griswold teaches this matter (column 3 lines 38-41 and column 4 lines 34-40 and column 7 line 3-26 and Figs. 1-2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the rights licensor in Misra's teaching to pricing, payment and delivery rules as taught by Griswold for allowing the rights licensor to better managing his or her property.

As to claims 21-22, Misra teaches a method of managing and licensing rights associated with media. Misra does not specifically teach the media is a movie or a musical performance. However, Griswold teaches this matter (column 1 lines 16-22). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the media in Misra's teaching to include a movie or a musical performance as taught by Griswold because this would expand the usage environment of Misra to attract more users to use Misra's teaching for efficiently managing licensing rights.

As to claim 23, Misra teaches a method of managing and licensing rights associated with media. Misra does not specifically teach the media is a movie or a

Art Unit: 3621

musical performance. However, Griswold teaches the media comprising various types of products (column 1 lines 16-22). It would have been obvious to one of ordinary skill in the art allow the product in Griswold's teaching to include a photograph because this would expand the usage environment of Griswold. For the same reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the media in Misra's teaching to include a photograph as taught by the modified teaching of Griswold because this would expand the usage environment of Misra to attract more users to use Misra's teaching for efficiently managing licensing rights.

As to claim 29, Misra teaches an apparatus for managing licensing transactions as discussed in claim 25 above. Misra does not specifically teach the licensing terms include a payment due date. However, Griswold teaches this matter (column 7 lines 14-24 and Fig. 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the licensing terms in Misra's teaching to include a payment due data for ensuring the royalty payment to the licensor.

8. Claims 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Misra et al., U. S. Patent 6,189,146 in view of Domenikos, U. S. Patent 5,838,910.

As to claim 10, Misra teaches the repository is configured to determine the availability of intellectual property rights through bi-directional navigation and implied data relations (Fig. 3). Misra does not specifically teach determining the availability of intellectual property rights through bi-directional hierarchical navigation relations. However, Domenikos teaches property rights file is stored in a hierarchical relationship (column 3 lines 49-55 and column 5 lines 33-39). It would have been obvious to one of

Art Unit: 3621

ordinary skill in the art at the time the invention was made to allow the intellectual property rights in Misra's teaching to be determined through hierarchical relationship so that the intellectual property rights can be more efficiently managed.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (571)-272-6705. The examiner can normally be reached on Monday – Thursday from 10:00 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (571) 272-6712.

Art Unit: 3621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(571) 273-8300	(Official Communications; including After Final Communications labeled "BOX AF")
(571) 273-6705	(Draft Communications)

Mary Cheung
Primary Examiner
Art Unit 3621
July 18, 2005

MARY D. CHEUNG
PRIMARY EXAMINER

